

REMARKS

Claims 1 to 26 were pending. Claims 7, 18, 21, 22 and 26 are canceled herein, and new claims 27 to 31 are added.

In the office action of August 19, 2004, claims 1 to 5 and 8 to 15 were allowed, and claims 6, 7, 16, 18, 21 and 25 were rejected. Claims 17, 19 to 20, 23 to 24, and 26 were objected to, but noted as allowable.

Reconsideration and reexamination in view of the amendments and arguments herein is respectfully requested.

35 U.S.C. §112 Rejection

Claims 6 stands rejected under 35 U.S.C. §112 as being indefinite. The term "lightweight" in claim 6 is alleged to be a relative term which renders the claim indefinite. Amendment has been made to claim 6 adding limitations that are more specific to the properties of the material. The claim language added appears in other claims as originally filed, see e.g., claim 1, and thus no new matter is added. Claim 6 as amended is believed to overcome the §112 rejection.

35 U.S.C. §102 Rejection

Although 35 U.S.C. §102 is mentioned on the bottom of page 2 of the office action, no specific claim was rejected under this section of the statute. Accordingly, no response is required.

35 U.S.C. §103(a) Rejection

Claims 6, 16, and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Esko et al. in view of engineering design choice. The examiner alleges that Esko et al. teaches all limitations of the claims with the exception of the selection of a known material such as hardened steel, which selection is a design consideration. Applicants believe that the claims as amended are patentable.

Claim 6 was amended to overcome the 35 USC § 112 rejection as discussed above. The amended claim 6 is also believed to be patentable over Esko et al. Claim 6 includes the limitations that "said substrate having a bulk density no greater than about 6 g/cc and a specific stiffness at least 50

percent greater than that of said hardened steel surface element", and further requires that the composite substrate is "permanently adhered" to the hardened steel surface element. The combination of elements and limitations in the present claim 16, including those added in the present amendment, are not disclosed or suggested in Esko et al., and thus claim 6 is believed patentable.

Claim 16 also stands rejected under 35 U.S.C. §103(a). Claim 16 has been amended to include the limitations of claim 26 which originally depended from claim 16 and which was noted as allowable in the office action. Claim 16 is thus believed patentable. As claim 25 depends from claim 16, and is further limited, it is believed patentable for at least the reasons claim 16 is patentable.

New claim 27 depends from claim 1. Since claim 1 is allowed, and claim 27 is further limited, the claim is believed patentable at least for the reasons claim 1 is patentable. The permanent attachment of the guideway to the chassis is supported in the specification and thus no new matter is added, e.g., see the specification at page 14, line 10.

New claim 28, depends from claim 27 which depends from claim 1, and is believed patentable at least for the same reasons. Support for the solder composition as claimed is found in the specification on page 15, lines 1-5.

New claim 29, depending from claim 8, is believed patentable at least for the same reasons. Support for the permanent attachment as claimed is found in the specification on page 14, line 10.

New claim 30, depending from claim 8, is believed patentable at least for the same reasons as claim 8. Support for the stiffness limitation can be found in original claim 1.

New claim 31, depending from claim 16, is believed patentable at least for the same reasons as claim 16. Support for the various elements and limitations can be found in the above discussed claims.

Conclusion

For the reasons set forth above, claims 1-6, 8-17, 19, 20, 23-25, 27-31 are believed patentable. An early allowance is respectfully requested.

Respectfully submitted,

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Gary A. Hecht, Reg. No. 36,826
SYNNESTVEDT & LECHNER LLP
1101 Market Street
2600 Aramark Tower
Philadelphia, PA 19107-2950
Tele: (215) 923-4466
Fax: (215) 923-2189

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